

REMARKS/ARGUMENTS

Claims 1, 2, 4-26, and 28-33 are pending, with claims 22-26, 28, 29, and 31-33 being withdrawn from consideration at this time. Reconsideration and allowance of the pending claims are respectfully requested.

35 U.S.C. §102(b) Rejections

In the Office Action dated July 5, 2007, claims 1, 4-10, 12, 14, 17-21, and 30 were rejected under 35 U.S.C. §102(b) as being anticipated by Yan (U.S. Patent No. 6,066,156). Applicant respectfully traverses this rejection.

Independent claim 1 recites an apparatus for treating a vascular condition that includes, *inter alia*, “a balloon including an outer first layer and an inner second layer, the outer first layer covering only a limited portion of the inner second layer; and a stent disposed on the outer first layer of the balloon.” As recited by claim 1, “the outer first layer flows into gaps formed in the stent when the apparatus is heated to a predetermined temperature, and retains the stent on the balloon during intravascular movement and the inner second layer does not flow into the gaps.” Yan does not disclose, teach, or suggest all of the features of claim 1.

MPEP §2131 makes clear that the elements in the prior art reference must be arranged as required by the claim. *See Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989) (“[t]he identical invention must be shown in as complete detail as is contained in the ... claim”) (emphasis added). As discussed in the Amendment filed on April 12, 2007, Yan teaches distinctly separate embodiments, which are illustrated in Figures 1 and 3. Neither of the embodiments disclosed by Yan anticipate claim 1, because each of these embodiments lacks at least one feature of claim 1.

Moreover, Yan expressly teaches away from claim 1. Specifically, the embodiment illustrated by Figure 3 of Yan is described as having no adhesive between the stent and the balloon “which should facilitate separation of the stent from the inflated balloon.” *See* Yan at col. 7, lns. 3-7. As such, Yan actually teaches away from combining the two embodiments disclosed therein. Simply put, claim 1 does not “read on” Yan, because Yan does not disclose or remotely suggest a single embodiment that includes each and every feature of claim 1.

Because neither embodiment of Yan discloses that the stent is disposed on the outer first layer of the balloon and that the outer first layer flows into the gaps of the stent, Yan does not anticipate claim 1 and the claims that depend from claim 1.

Independent claim 9 recites a balloon stent assembly system that includes “a balloon including at least one non-tacky outer layer and at least one inner layer, the non-tacky outer layer covering only a limited portion of the at least one inner second layer; and a stent disposed on the outer layer.” As further recited by claim 9, “when the balloon is heated at a predetermined temperature the outer layer flows into gaps formed in the stent while the inner layer does not flow.” Yan does not disclose, teach, or suggest all of the features of claim 9 either.

As discussed above, the separate embodiments taught by Yan teach various arrangements of a stent on a balloon. However, neither arrangement includes all of the features of claim 9. Moreover, the embodiment illustrated in Figure 1 of Yan includes a tacky adhesive that is located between the stent and the balloon and holds the stent on the balloon until the stent is delivered to the targeted site. *See* Yan at col. 5, ln. 57 – col. 6, ln. 2. Therefore, Yan does not anticipate claim 9 or the claims that depend from claim 9 for this additional reason.

In view of the foregoing, Applicant respectfully submits that claims 1 and 9 and the claims that depend therefrom, and include additional advantageous features, are patentable over Yan, and respectfully requests that the rejection of claims 1, 4-10, 12, 14, 17-21, and 30 be withdrawn.

35 U.S.C. §103(a) Rejections

In the Office Action, claims 2, 11, 13, 15, and 16 were rejected under 35 U.S.C. §103(a) as being unpatentable over Yan. Applicant respectfully traverses this rejection.

Claim 2 depends from claim 1, and claims 11, 13, 15, and 16 depend from claim 9. As discussed above, claims 1 and 9 and the claims that depend therefrom are patentable over Yan because Yan does not teach a single embodiment that includes all of the features of claims 1 and 9. Applicant respectfully submits that Yan does not remotely suggest that the embodiments disclosed therein may be combined or that there would be any desire for one of ordinary skill in the art to make such a combination, and actually teaches away from combining the two embodiments, as discussed above.

Moreover, Applicant respectfully submits that *In re Aller* does not apply here, because “the general conditions of the claim” are not met. *See* MPEP §2144.04 (“if the facts in a prior legal decision are sufficiently similar to those in an application under examination, the examiner may use the rationale used by the court”). As discussed above, Yan does not disclose, teach or suggest all of the features of claims 1 and 9. For at least this reason alone, the “general conditions” of the claim are not be met by Yan.

The “general conditions” of the claims are also not met by Yan because Yan teaches that the adhesive used in between the stent and the balloon, in the embodiment illustrated in Figure 1, loses its tackiness at temperatures above about 38° C, which is far below the ranges recited by claims 2 and 16. As such, the ranges recited by claims 2 and 16 would not work with the assembly of Yan. Moreover, Yan is completely silent as to stent retention forces, and therefore does not disclose “the general conditions” recited by claims 11, 13, and 15.

In view of the foregoing, Applicant respectfully submits that claims 2, 11, 13, 15, and 16 are patentable over Yan for these additional reasons, and respectfully requests that the rejection to these claims be withdrawn.

Conclusion

For the foregoing reasons, Applicant believes all the pending claims are in condition for allowance and should be passed to issue. The Commissioner is hereby authorized to charge any additional fees which may be required under 37 C.F.R. §1.17, or credit any overpayment, to Deposit Account No. 01-2525. If the Examiner feels that a telephone conference would in any way expedite the prosecution of the application, please do not hesitate to call the undersigned at telephone (707) 543-0221.

Respectfully submitted,

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